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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/667,779	09/22/2000	Nicolas Brogne	Q60742	1269

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Sughrue Mion Zinn MacPeak & Seas PLLC
2100 Pennsylvania Avenue NW
Washington, DC 20037-3213

EXAMINER

DINH, KHANH Q

ART UNIT	PAPER NUMBER
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2151

DATE MAILED: 06/03/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/667,779

Applicant(s)

BROGNE ET AL.

Examiner

Khanh Dinh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to the Amendment filed on 3/16/2004 (paper # 8). Claims 1-12 are presented for examination.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Nielsen U.S. pat. No.5,870,548.

As to claim 1, Nielsen discloses a method of manipulating a sent e-mail, addressed by a sender (407 fig.4) to a plurality of addresses (recipients), said sent email comprising an address header and a body, said method comprising:

routing a modification message (action message including: modify or cancel message 409 fig.4) over a data network (sending a message over Internet) to a server (using server 200 fig.2), on which at least the body of said sent e-mail is stored, said modification message being sent by said sender (409 fig.4) for modifying said e-mail body (using sender's process to alter previously sent messages, see abstract, figs.2, 6C, col.6 lines 4-67, col.7 line 2-65).

modifying said e-mail's body at said server according to said modification message (sender can edit text in the 679 and 687 of fig.6D), if mail's body has not been accessed on said server by any of said addressees (see figs. 5, 6D, 11A, col.8 line 4 to col.9 line 22 and col.15 line 41 to col.16 line 60).

As to claim 2, Nielsen discloses modification of said email consists in deleting said e-mail body or modifying a part of said e-mail body (see col.6 lines 18-43), said sender being informed by said server if said modification has been executed or not (see col.8 line 29 to col.9 line 63 and col.10 line 21 to col.11 line 43).

As to claim 3, Nielsen discloses a server (200 fig.2) to be part of an e-mail system, said server being able to receive, from a data network (Internet 205 fig.2), an e-mail comprising an address header and a body by a sender (201 fig.2) to a plurality of addressees (recipients), said server comprising:

means for storing at least the body of said received e-mail together with an access code (message ID)(see figs.2, 6A-6D, col.7 line 40 to col.8 line 59 and col.9 line 22 to col.10 line 58).

means for sending to each addressee a notification message of said e-mail, said notification message containing the access code for accessing said e-mail body (see fig.7A, col.10 lines 1-40) and means for handling a status storage indicating at least whether said e-mail body has been accessed by one of said addressees (see col.7 line 20 to col.8 line 59 and col.10 line 41 to col.11 line 30).

means for receiving a modification message, dedicated to modify said e-mail body and means for modifying said e-mail body according to said modification message, if said e-mail's body has not been accessed by any of said addressees (see fig.11A, col.11 line 13 to col.12 line 38 and col.15 line 41 to col.16 line 60).

As to claim 4, Nielsen discloses sending a message to the sender of said modification message to notify the sender if the modification has been executed or not (see col.8 line 29 to col.9 line 63 and col.10 line 21 to col.11 line 43).

As to claim 5, Nielsen disclose sending a message to the sender of said e-mail containing said access code (message ID) associated to said e-mail (see figs.2, 6A-6D, col.7 line 40 to col.8 line 59 and col.9 lines 22-67).

As to claim 6, Nielsen discloses downloading said e-mail body to one of said addressee providing said access code and deleting said e-mail body at said server when each one of said addressees has accessed said e-mail body at said server) (see figs.2, 6A-6D, 7A, col.7 line 40 to col.8 line 59, col.9 lines 22-67 and col.10 line 21 to col.11 line 43).

As to claim 7, Nielsen discloses storing the header of said e-mail and executing an authentication procedure when a user tries to access said e-mail body by providing said access code (message ID) (see figs.2, 6A-6D, 7A, col.7 line 40 to col.8 line 59, col.9 lines 22-67 and col.10 line 21 to col.11 line 43).

As to claim 8, Nielsen discloses storing the header of said e-mail and receiving a modification message, dedicated to modifying said e-mail header only to said e-mail body and modifying said e-mail header according to said modification message, if said e-mail has not been accessed by any of said addressees (see figs.2, 6A-6D, 7A, col.7 line 40 to col.8 line 59, col.9 lines 22-67 and col.15 line 41 to col.16 line 60).

As to claim 9, Nielsen discloses storing the header of said e-mail and sending to said addressees an e-mail containing said e-mail's header and said e-mail's body after a predefined time period and deleting (canceling) at said server said e-mail's header and said e-mail's body (see figs. 7A-7C, 8A-8C, col.10 line 21 to col.11 line 43 and col.11 line 44 to col.12 line 64).

As to claim 10, Nielsen discloses storing the body of a received e-mail together with an access code (message ID) and sending to each addressee of said e-mail a notification containing the access code for accessing said e-mail body (see figs.8A-C, col.11 line 44 to col.12 line 64 and col.13 line 23 to col.14 line 64), handling a status storage indicating at least whether said e-mail body has been accessed by one of said addressees (if the recipient has seen the message, see

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col.14 lines 45-64) and if a modification message for modifying said e-mail body is received, modifying said e-mail body according to said modification message, if said e-mail body has not been accessed on said server by any of said addressees (see fig.11A, col.14 line 45 to col.16 line 25).

As to claims 11 and 12, Nielsen discloses a computer program product to be executed on a computer comprising computer program code embodied on a computer-readable medium, said computer program code means adapted to perform following steps:

composing a modification message for modifying an e-mail addressed to a plurality of addressees (e-mail recipients) and sent to a predefined server (200 fig.2) (altering previously sent messages, see abstract, fig.2, col.6 lines 4-67 and col.7 line 1-19).

sending said modification message to said server to modify at least the body of the email sent to and stored on said predefined server if the email body has not been accessed on said server by any of addressee (see figs.4, 5, col.7 line 20 to col.9 line 21 and col.15 line 41 to col.16 line 60).

Response to Arguments

4. Applicant's arguments filed on 3/16/2004 (paper # 8) have been fully considered but they are not persuasive.

* Applicant requests the Examiner to consider the references listed on the PTO-1449 form submitted with the IDS filed on September 22, 2000.

Upon reviewing the file, Examiner could not find the IDS as stated by the Applicant.

Therefore, the Examiner requests the Applicant to resubmit the IDS together with its PTO post card so that it can be considered.

* Applicant asserts that the cited reference fails to disclose modification of the content of the original email message sent to a plurality of addressees.

Examiner respectfully disagrees. Nielsen discloses modification of the content of the original email message sent to a plurality of addressees (sender activates "modify this message" control to allow user to view and edit the entire text (679 and 687 of fig.6D) of the selected previously-sent message, see fig.6D, col.7 lines 20-65 and col.8 line 2 to col.9 line 22). The sender can select and modify the email message according to desire operations that cause some actions at the recipients' email system. Therefore, Nielsen discloses the Applicant claimed invention.

* Applicant asserts that the Nielsen reference does not disclose sending out an access code and modification of the e-mail body is executed as long as the plurality of addressees has not accessed the email body stored on the server.

Examiner respectfully point that the Nielsen reference discloses using an access code (using a header including a message ID and implement encryption to provide authentication protection to the previous-sent message, see col.10 lines 6-63) and modification of the e-mail body is executed as long as the plurality of addressees has not accessed the email body stored on the server (using the Inbox to maintain information as

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whether the recipient has seen the message and processing modification to the message, see fig.11A, col.15 line 41 to ocl.16 line 60).

Therefore, the examiner asserts that cited prior art teaches or suggests the subject matter broadly recited in independent claims 1, 3 and 11.

Claims 2, 4 -10 and 12 are also rejected at least by virtue of their dependency on independent claims and by other reasons set forth in the previous office action [see paper no. 7]. Accordingly, claims 1-12 are respectfully rejected.

Conclusion

5. Claims 1-12 are rejected.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh Dinh whose telephone number is (703) 308-8528. The examiner can normally be reached on Monday through Friday from 8:00 A.m. to 5:00 P.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess, can be reached on (703) 305-4792. The fax phone number for this group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305 -9600.


FRANTZ B. JEAN
PRIMARY EXAMINER

Khanh Dinh
Patent Examiner
Art Unit 2151
5/25/2004